



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/766,541 | 01/28/2004 | David Robison | CRS / 275 | 3109 |

26875 7590 01/25/2006
WOOD, HERRON & EVANS, LLP
2700 CAREW TOWER
441 VINE STREET
CINCINNATI, OH 45202

EXAMINER

GRAY, LINDA LAMEY

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1734

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,541

Applicant(s)

ROBISON ET AL.

Examiner

Linda L. Gray

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-6 and 9 is/are allowed.
- 6) ☒ Claim(s) 1,2,8 and 10 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Farrow (US 5,970,640).

Claims 1 and 10, Farrow teaches a method of applying a seam tape along an edge of a sheet of membrane 11 wherein the tape includes pressure sensitive adhesive strip 12 covered on a first surface with release sheet 13 (c 1, L 65, to c 2, L 49; c 2, L 48, to c 3, L 25). The method includes applying the tape to a center portion of membrane 11 by pressing to some degree a second top surface of the tape against membrane 11 to bond (c 2, L 40-47). Then the method includes cutting membrane 11 into two sheets by cutting through membrane 11 and the tape along a central portion of the tape to form the two sheets having a continuous portion of the tape along one edge.

With respect to the limitation in claim 1 of "adapted for use as a roofing membrane" and "roofing membrane" (L 1), such refers to an intended use of the two sheets made using the claimed method and does not provide patentable subject matter to claim 1. The limitation does not further limit the steps of the claimed method. The same applies to claim 10 with respect to "adapted for use as a pond liner" and "pond liner" (L 1).

Claim Rejections - 35 USC § 103

3. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Farrow in view of Leibmann.

Farrow does not teach cutting while applying the tape.

Liebmann teaches a method of applying seam tape 14 along an edge of a sheet of membrane 20 wherein tape 14 includes pressure sensitive adhesive strip 15 covered on a first

Art Unit: 1734

surface with release sheet 12. The method includes applying tape 14 to a center portion of membrane 20 by pressing a second top surface of tape 14 against membrane 20. Then the method includes cutting membrane 20 into two sheets by cutting through membrane 20 and tape 14 along a central portion of tape 14 to form the two sheets having a portion of tape 14 along one edge. See Figures 3 and 3A which teaches an apparatus that demonstrates cutting while applying tape 14 (c 3-6).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Farrow cutting while applying the tape because Liebmann teaches in the same art of applying tape to a surface that such is conventional in the art and it is obvious to replace one method to apply/cut tape (that of Farrow) with another art recognized alternative method to apply/cut tape (that of Liebmann) where Farrow does not place restrictions on the cutting operation such that one skilled in the art would not consider the modification to be detrimental to the process of Farrow.

4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Farrow.

Farrow teaches membrane 11 to be paper as an improvement over vinyl per se and teaches in the prior art discussion using plastic too (c 1, L 9-10). But Farrow does not teach using EPDM.

However, in the art of making signs, where Farrow is making signs (c 1, para 1), EPDM is a conventional alternative sign material, and it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Farrow that membrane 11 be EPDM because it is obvious to replace one material for a sign with another art recognized alternative sign material.

Allowable Subject Matter

5. Claim 3 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 4-6 and 9 are allowed.

6. The following is a statement of reasons for the indication of allowable subject matter:

claim 3: in Farrow in view of Liebmann membrane 11 is supported on a surface where a surface having central grooves aligned with a portion of a material to be cut is conventional; however, Farrow does not teach a seam tape applicator sheet splitter to be run along membrane 11 to apply the tape and cut membrane 11 in that in Farrow modified membrane 11 is moved past stationary applicators and cutters,

claim 6: Farrow in view of Liebmann teaches an apparatus for applying the seam tape along an edge of membrane 11 including a seam tape applicator having a contact roll adapted to press the tape against a surface of membrane 11 where the applicator supports a roll of the tape where the tape includes pressure sensitive adhesive layer 12 having first and second adhesive surfaces and release sheet 13 covering one of the adhesive surfaces, and a splitter adapted to slit through the tape and membrane 11 where the limitation of membrane 11 being a roofing membrane per se refers to the material operated upon and does not further limit the structure of the apparatus claimed; however, Farrow modified by Liebmann does not teach that the apparatus includes a handle providing means to push the apparatus over membrane 11 in that in Farrow modified membrane 11 is moved past stationary applicators and cutters, and

claim 9: Farrow in view of Liebmann teaches an apparatus for applying the seam tape along an edge of membrane 11 including a seam tape applicator having a contact roll adapted to press the tape against a surface of membrane 11 where the applicator supports a roll of the tape where the tape includes pressure sensitive adhesive layer 12 having first and second adhesive surfaces and release sheet 13 covering one of the adhesive surfaces, and a splitter adapted to slit through the tape and membrane 11 where the limitation of membrane 11 being a roofing membrane per se refers to the material operated upon and does not further limit the structure of the apparatus claimed; however, Farrow modified by Liebmann does not teach guides which includes a plurality of disks located along a central axis of the apparatus.

7. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Response

8. Applicant's comments filed 11-16-05 have been fully considered.

Applicant indicates with respect to claim 1 (page 6, response) that the use of a membrane adapted for use as a roofing membrane as a starting material is distinguishable from

Art Unit: 1734

the disclosure of Farrow which teaches using a paper substrate in that a membrane which is adapted for use as a roofing membrane is waterproof, polymeric, thick, and heavy.

In response, claim 1 does not recite specific materials for the membrane that would require the membrane in claim 1 to be waterproof, polymeric, thick, and/or heavy. The membrane of claim 1 is not structurally different from membrane 11 of Farrow. Use of adapted for use as a roofing membrane, as in claim 1, refers to an intended use of the two sheets made using the claimed method and does not provide a patentable structural difference between membrane 11 of Farrow and the membrane of claim 1.

Applicant indicates with respect to claim 8 (page 7, response) that claim 8 recites the membrane to be EPDM and that the type of signage disclosed in Farrow would not be formed from EPDM because Farrow intends to make a disposable sign. Applicant indicates that it would be illogical and impractical to form disposable signs from EPDM such that it would not be obvious to modify Farrow to use EPDM.

In response, Farrow makes signs which in theory are disposable although the reference does not specifically recite how the signs are treated after the usefulness has ended. Thus, one skilled in the art reading the Farrow reference would not automatically assume the signs are thrown away. Other equally viable options could be applying a sticker over the surface of the sign including updated consumer information. In any event, such speculation is not necessary since the reference stops short of indicating what is to occur after the usefulness of the sign has ended.

It is also noted that Farrow teaches, in the prior art, that plastic signs are well-known in the art. Paper isn't used as membrane 11 over the overall idea of plastic per se, just vinyl materials. Thus, one skilled in the art would automatically assume that non-paper materials would be inappropriate.

Conclusion

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

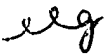
Art Unit: 1734

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linda L. Gray whose telephone number is (571) 272-1228. The examiner can normally be reached on Monday-Friday, 9:00am to 5:00pm.

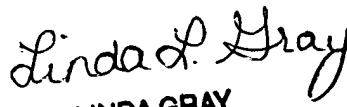
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

llg



January 23, 2006


LINDA GRAY
PRIMARY EXAMINER